

REMARKS

Claims 1, 2 and 4-20 are pending in this application, claims 7-19 having been withdrawn from consideration. By this Amendment, claims 1, 7, 14 and 20 are amended, and claim 3 is canceled without prejudice to or disclaimer of the subject matter set forth therein. Support for the amendments to claims 1 and 20 can be found in the specification as originally filed, for example, at page 4, line 22 - page 5, line 2; page 11, line 14 - page 13, line 4; Examples 7-11 at page 48, line 5 - page 67, line 7; and in original claims 1, 3, 7, 14 and 20. Thus, no new matter is added by these amendments.

I. Restriction Requirement

Claims 1-20 are subject to a Restriction Requirement. Applicants elected Group I, claims 1-6 and 20; accordingly, claims 2-4 and 6-8 are withdrawn from consideration. Applicants respectfully traverse the Restriction Requirement.

The Restriction Requirement is traversed because the claims of Groups I, II and III are drawn to sufficiently inter-related inventions to warrant examination thereof in a single application. Group I is drawn to a toner for electrophotography. Group II is drawn to an image-forming method using a toner for electrophotography, and Group III is drawn to an image-forming apparatus in which a means for developing an electrostatic latent image uses a toner for electrophotography.

With respect to Groups I and II, where product and process claims are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. *See* MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. *Id.* In the instant application, the method claims of Group II include all of the limitations of the product of Group I. In particular, all of the limitations of the independent product claim 1 of

Group I are incorporated into the methods of Group II. Because the method claims of Group II include the limitations of the product claims of Group I, the method claims must be rejoined with the product claims once the product claims are allowed. Thus, to streamline prosecution and avoid delay, the Restriction Requirement should be withdrawn to permit concurrent examination of all of the claims of Groups I and II.

Similarly, the apparatus claims of Group III include all of the limitations of the product of Group I. In particular, all of the limitations of the independent product claim 1 of Group I are incorporated into the apparatuses claims of Group III. To streamline prosecution and avoid delay, the Restriction Requirement should be withdrawn to permit concurrent examination of all of the claims of Groups I and III.

The Restriction Requirement is also traversed because the subject matter of Groups I, II and III is sufficiently related that a search of any one group would encompass a search of the subject matter of the remaining group. The prior art revealed by a search of the toner of Group I would overlap the prior art revealed by a search of image-forming methods and apparatuses using such toner. Thus, although the classifications may be different, the subject matter is sufficiently overlapping that concurrent search of all of the claims does not create a serious burden.

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent claims. MPEP §803. As discussed above, there would be no serious burden on the Patent Office to examine all of the present claims because Groups I, II and III are sufficiently related that a search of the subject matter of any one group would encompass the search of the subject matter of the remaining groups. Thus, the Restriction Requirement is improper and should be withdrawn.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement.

II. Claim Rejections

A. Claims 1, 2, 5, 6 and 20

The Office Action rejects claims 1, 5, 6 and 20 under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) over U.S. Patent No. 5,753,399 to Hayase et al. The Office Action also rejects claims 1, 5 and 6 under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2002/0051924 to Iida et al., and rejects claim 2 under 35 U.S.C. §103(a) over Iida. Applicants respectfully traverse these rejections.

Independent claim 1, from which claims 2, 5 and 6 depend, and independent claim 20 have been amended herein to incorporate the subject matter of claim 3, which was not rejected over either Hayase or Iida. Because neither Hayase or Iida disclose the subject matter of claim 3, Applicants respectfully submit that amended claims 1 and 20, which incorporate this subject matter, are not anticipated by and would not have been obvious over Hayase or Iida.

For at least this reason, claims 1, 2, 5, 6 and 20 are not anticipated by Hayase or Iida and would not have been obvious over Hayase or Iida. Reconsideration and withdrawal of these rejections are respectfully requested.

B. Claims 3 and 4

The Office Action rejects claims 3 and 4 under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2002/0051924 to Iida et al. in view of U.S. Patent No. 5,827,632 to Inaba et al. Applicants respectfully traverse this rejection with respect to claim 4, claim 3 having been canceled herein.

Claim 4 depends from independent claim 1, which sets forth a "toner for electrophotography comprising toner particles that comprise a binder resin, a coloring agent, a release agent, and inorganic or organic particles, wherein the inorganic or organic particles have a particle diameter of 5 to 200 nm and are present in an amount of 1 to 30% by mass, wherein the toner has a storage modulus G' of 5.0×10^2 to 1.0×10^5 Pa at 180°C and an adhesive force to an aluminum substrate of not more than 50 N/m at 180°C."

The Office Action takes the position that claim 4 would have been obvious over the teachings of Iida in combination with Inaba. Applicants respectfully disagree.

Iida teaches toners that include binder resin, wax and colorant, and that have a storage modulus between 120 and 180°C in within the claimed range. *See Iida, Abstract.* As admitted by the Office Action, Iida does not teach incorporating inorganic and/or organic particles that have the claimed particle sizes into its toners in the claimed amounts. Iida only discloses that its toner particles may be blended with external flowability additives such as silica, titania or alumina particles. *See Iida, [0098].* However, Iida does not teach or suggest toners that include toner particles that include, within the toner particles themselves, a binder resin, a coloring agent, a release agent, and inorganic or organic particles having the claimed particle sizes.

Inaba teaches toners in which toner particles, hydrophobized inorganic fine powders and hydrophobized silica fine powders are combined together. *See Inaba, Abstract.* However, the hydrophobized inorganic fine powders and hydrophobized silica fine powders are external additives and are not incorporated into the toner particles themselves. Rather, the hydrophobized silica fine powders are incorporated into the toner composition to prevent hydrophobized inorganic fine powders from becoming embedded in the toner particle surface. *See Inaba, Abstract; co. 14, lines 46-49.*

Because neither of the cited references teach or suggest including inorganic or organic particles having a particle diameter of 5 to 200 nm in their toner particles in an amount of 1 to 30% by mass, no combination of Iida and Inaba would have rendered obvious this feature of independent claim 1 (and its dependent claims, including claim 4).

For at least these reasons, Applicants respectfully submit that claim 4, and independent claim 1, are patentable over Iida and Inaba, individually or in combination. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejoinder of Withdrawn Claims 7-19

Because product claims 1, 2, 4-6 and 20 are allowable for the reasons discussed above, Applicants respectfully request rejoinder of corresponding withdrawn process claims 7-13 and withdrawn apparatus claims 14-19.

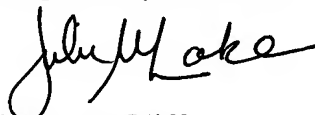
Rejoinder is proper under MPEP §821.04 because the withdrawn claims "depend from or otherwise include all of the limitations of the allowable product claim."

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2 and 4-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: June 6, 2006

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